

## **REMARKS / ARGUMENTS**

### **I. General Remarks and Remarks Regarding the Restriction Requirement**

Please consider the application in view of the following remarks. Applicants thank the Examiner for his careful consideration of this application.

On February 24, 2006, during a telephone conversation with the Examiner, claims 1-48 were provisionally elected in response to the Examiner's restriction requirement. This provisional election is hereby confirmed, and claims 49-68 have been cancelled. Applicants reserve the right to present the cancelled claims in one or more continuing applications.

### **II. Disposition of Claims**

Claims 1-69 are pending in this application. Claims 49-68 have been cancelled herein. Claim 69 is new.

In this response, claims 1, 5, 12, 22, 26, 29-32, 38, 40, 46, and 48 have been amended, and claim 69 has been added. These amendments are supported by the specification as filed.

Claims 5, 12, 26, 38, and 46 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 1-9, 17, and 19-31 stand rejected under 35 U.S.C. § 102(b). Claims 18 and 32 stand rejected under 35 U.S.C. § 103(a). The Examiner has objected to claims 10, 11, 13-16, and 29-32.

### **III. Objections to the Specification**

The Examiner has objected to the specification because the "CROSS REFERENCE TO RELATED APPLICATIONS fails to set forth all of the copending and/or related cases." (Office Action at page 3.) In this response, Applicants have amended the specification in accordance with the Examiner's request to list all cases related to the present application. Accordingly, Applicants respectfully request the withdrawal of this objection thereto.

The Examiner has further objected to the specification because "[t]hroughout the specification . . . the term 'orthoester' is recited. It appears, e.g., upon review of the cited literature, that such term should actually be recited or appear, instead, as -- ortho ester -- . Thus, the term 'othoester' may be technically inaccurate." (Office Action at page 3.) Applicants respectfully disagree with this objection. Applicants respectfully assert that their use of the term "orthoester" is not objectionable since it introduces no uncertainty into the scope of the claims,

and a person of skill in the art would understand the meaning of that term. *See* MANUAL OF PATENT EXAMINING PROCEDURE § 2173.02 (2006) (the “focus” during examination of claims “is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. . . . Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.”). Indeed, much of the cited literature--including the reference cited in the Office Action--also uses the term “orthoester”, as these two spellings appear to be interchangeable. *See, e.g.,* U.S. Patent No. 5,504,235 to Hirose *et al.* at col. 2, l. 29. Therefore, Applicants respectfully assert that their use of the term “orthoester” in the present application is not objectionable, and request the withdrawal of the objections thereto.

#### **IV. Objections to Claims**

Claims 29-32 stand objected to because “they appear to be duplicates of previous claims,” specifically, claims 8, 9, 17, and 18 respectively. (Office Action at page 3.) In this response, Applicants have amended claims 29-32 to correct a typographical error in their dependency such that, as amended, these claims properly depend, directly or indirectly, from claim 22. Thus, as amended, claims 29-32 are not duplicates of previous claims, and thus Applicants respectfully request the withdrawal of the objections thereto.

#### **V. Rejections of Claims**

##### **A. Rejections of Claims Under 35 U.S.C. § 112, Second Paragraph**

Claims 5, 12, 26, 38, and 46 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (*See* Office Action at page 4.) Specifically, the Office Action states that these claims are deemed indefinite for being drawn to improper Markush groupings. *Id.* In this response, Applicants have amended each of these claims to conform with the Examiner’s wishes. Accordingly, Applicants respectfully request the withdrawal of these rejections.

##### **B. Rejections of Claims Under 35 U.S.C. § 102(b)**

Claims 1-9, 17, and 19-31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,504,235 to Hirose *et al.* (“Hirose”). With respect to these rejections, the Office Action states:

Hirose et al discloses a method for decomposing a polysiloxane or silicone polymer compound or mixture, such as a silicone oil, into a silane compound, such as an alkoxysilane, by in one embodiment, contacting the polysiloxane, such as a silicone oil, with an acid generated from an ortho ester.

While Hirose et al is not explicitly directed to viscosity reduction, it is deemed that in carrying out the embodiment(s) of Hirose et al, wherein the polysiloxane or silicone is in the form of a fluid, such as silicone oil, the step(s) of contacting such polysiloxane fluid with the ortho ester composition, such that the polysiloxane is decomposed by the acid generated from the ortho ester, will inherently or necessarily reduce the viscosity of the polysiloxane fluid. Such viscosity reduction is deemed to occur insofar as the polysiloxane or silicone, which comprises a large polysiloxane compound, will possess a higher viscosity, e.g., in being a polymer, than the resulting silane decomposition product, which chemically resembles the alkane class of compounds. Further in this regard, no patentable weight is accorded to the term "treatment fluid," e.g., as recited in independent claims 1 and 22, since it merely appears in the claim(s) preamble and/or no actual steps are recited for treating a well and/or subterranean formation.

As per claims 2-7 and 23-28, the ortho esters utilized by Hirose et al (note col. 2, lines 28-46) appear to encompass those recited in these claims, e.g., Hirose et al discloses use of ortho acetate.

As noted above with respect to claims 1 and 22, no patentable weight is accorded to the adjectives "fracturing" or "gravel pack" recited in claims 8, 9, 29 and 30 since no steps of actually fracturing or gravel packing a formation are set forth. Also, the polysiloxane or silicone, in the various forms disclosed, can be construed as a "gelling" agent (for what?) or "hydratable," as broadly recited. Moreover, the polysiloxane in the form of, e.g., a "silicone oil" appears to be capable of such use, in comprising a hydraulic fluid having a high viscosity due to the silicone component.

As per claims 17 and 31, the ortho ester composition utilized in the method of Hirose et al (note col. 4, lines 16-41) may further comprise water.

As per claim 19, Hirose et al (note col. 4, line 38-41) teaches that the water or active hydrogen-containing component may be used in less than a stoichiometric amount -- in which case, the water component can be construed as an "inhibitor," as broadly recited. Similarly, the use of such amount of water would then also impart a "desired delay period" to the decomposition, and accompanying reduction of viscosity, of the polysiloxane fluid.

As per claim 20, the ortho ester composition utilized by the method of Hirose et al appears to be at least in "solution" form.

(Office Action at pages 4-6.)

In order to form a basis for a § 102(b) rejection, a prior art reference must disclose each and every element as set forth in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004). In this response, Applicants have amended claims 1 and 22 to require contacting a viscosified treatment fluid in a subterranean formation with the acid generated from the orthoester composition. However, *Hirose* does not disclose a treatment fluid in a subterranean formation. Rather, *Hirose* is directed to the use of orthoesters in decomposing polysiloxanes used in the silicone industry. (*See Hirose* at col. 1, ll. 6-12.)

Applicants therefore respectfully assert that *Hirose* does anticipate claims 1 and 22, as amended herein, and thus those claims are patentable over *Hirose*. Moreover, since "a claim in dependent form shall be construed to incorporate by reference all the limitation of the claim to which it refers," and since claims 2-9, 17, 19-21, and 23-31 depend, either directly or indirectly, from claim 1 or 22, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

**C. Rejections of Claims Under 35 U.S.C. § 103(a)**

Claims 18 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hirose*. With respect to these rejections, the Office Action states:

Hirose et al may include water as a component for providing an active hydrogen-containing group in their ortho ester composition for treating the polysiloxane fluid.

Insofar as the reaction rate of the polysiloxane or silicone decomposition is directly related to the amount of active hydrogen-containing component, it is deemed that precise amount or range of water utilized would have been an obvious matter of choice or design, to one of ordinary skill in the art, based on, e.g., the actual polysiloxane or source of polysiloxane fluid, such as silicone oil, to be decomposed or encountered in the field.

(Office Action at pages 6-7.)

To form a basis for a § 103(a) rejection, a prior art reference must teach or suggest each element in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2142 (2004). However, as discussed in Section V.B. above, *Hirose* does not teach or suggest a viscosified

treatment fluid in a subterranean formation, as recited in claims 1 and 22, as amended herein. Because *Hirose* does not teach all elements of claims 1 and 22, it cannot obviate these claims. Since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 18 and 32 depend indirectly from claim 1 or 22, these dependent claims include the limitations of claims 1 and 22, that *Hirose* does not teach or suggest. See 35 U.S.C. § 112 ¶ 4 (2004). Therefore, Applicants respectfully assert that claims 18 and 32 are allowable over *Hirose*, and request the withdrawal of the rejections thereto.

#### **VI. Allowable Subject Matter**

The Office Action has objected to claims 10, 11, and 13-16 as being dependent upon a rejected base claim, but states that those claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (See Office Action at page 7.) As claims 10, 11, and 13-16 depend, either directly or indirectly, from claim 1, and claim 1, as amended herein, has been shown herein to be allowable, dependent claims 10, 11, and 13-16 are similarly allowable. Moreover, Applicants have rewritten original claim 10 in independent form, including all of the limitations of the base claim, as new claim 69, and thus claim 69 is similarly allowable. Therefore, Applicants respectfully request that claims 10, 11, 13-16, and 69 are allowable, as presented herein.

The Office Action also states that claims 12, 38, and 46 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph, set forth in the Office Action, and if claim 12 is rewritten to include all of the limitations of the base claim and any intervening claims. (See Office Action at page 7.) In this response, Applicants have amended claims 12, 38, and 46 to overcome the rejections under 35 U.S.C. § 112, second paragraph, and thus respectfully submit that these claims are allowable, as presented herein.

Moreover, the Office Action further states that claims 33-37, 39-45, 47, and 48 have been allowed. (See Office Action at page 7.) Applicants thank the Examiner for his allowance of these claims.

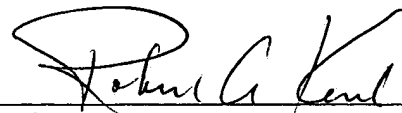
**SUMMARY AND PETITION FOR EXTENSION OF TIME OF TWO MONTHS TO  
FILE THIS RESPONSE**

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants hereby petition under the provisions of 37 C.F.R. § 1.136(a) for a two-month extension of time to file this Response.

The Commissioner is hereby authorized to debit the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300 in the amount of \$450.00 for a two-month extension of time fee. Applicants believe that no additional fees are due in association with the filing of this Response. However, should the Commissioner deem that any additional fees are due, the Commissioner is authorized to debit the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300, for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,



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